

2/9/2006 11:49 PM FROM: Fax TO: 1 571 273 8300 PAGE: 004 OF 006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner rejects claims 4, 9, 14-16, 21-23, 28-30, 35-37, 41, 44, asserting that the aforesaid claims are anticipated by U.S. 6,098,065 to Skillen et al. Examiner asserts that the claims are rejected because they recite "...the algorithm of said search engine is selected from a group consisting of deductive reasoning, fuzzy logic and abductive reasoning." However, claims 16, 23, 30 and 37 do not recite the above Markush language nor do they depend from claims that recite the above Markush language. Instead, these claims recite "the algorithm of said first search engine is the same as the algorithm of said second search engine." This was pointed out to Examiner in Applicant's reply to First Office Action on page 11. Examiner's reply in the final office action does not appear to be responsive to this point.

Based on the foregoing, reconsideration is earnestly requested.

In claims 6,18 and 32, Examiner did not cite the "specific statutory basis for rejection" as required by MPEP §2106(VII) .

Examiner first rejected claims 6,18 and 32 as being anticipated by Skillen, supra, under 35U.S.C. §102(b) because these claims contain the language "said user is a customer." In Examiner's first office action, Examiner alleges that the quoted language is "Nonfunctional descriptive material." Examiner went on to assert that such language "cannot render nonobvious an invention that would have otherwise been obvious." Neither obviousness nor anticipation was fully supported in Examiner's argument as demonstrated by Applicant on Page 13 of his response to first office action. However, while the point concerning nonfunctional descriptive material is debatable, Applicant does not feel that he has ever had a fair chance to rebut Examiner's argument because he did not know the specific statutory basis of rejection (Also see *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). Further, applicant

2/5

Szmanda, 09/982,640, D/N 801001

action.

Based on the foregoing, reconsideration is earnestly requested.

All elements of claims 1, 11, 25, 39 and 42, are not disclosed in the prior art as required by *In re Marshall* 198 USPQ 344,346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.")

Independent claims 1, 11 and 25, 39 and 42 were rejected under 35U.S.C. 102 over the Skillen reference. Every element of the aforesaid claims is not disclosed in the Skillen reference. For instance, "details of a plurality of advertisements" in claims 1,11 and 25 do not equate with either "Internet related information in the contextual data" or "product data" as cited by Examiner (Skillen: col. 4 lines 31-40). No examples of the user querying a database having "details of a plurality of advertisements" appear in Examiner's new citations (col. 2, lines 11-33 or col. 5 lines 50-57) or anywhere else in Skillen. Applicant respectfully points out that "product data" and "details of a plurality of advertisements" are not the same thing. Advertisements for products are not the products themselves.

As for Independent claims 39 and 42, Applicant's specification clearly sets forth the meaning of "search terms comprising words having targeted connotative significance to a particular demographic segment" for example in paragraphs 18 and 37. This is in no way what is disclosed in Examiner's citation of the Skillen reference (col. 2, lines 44-49). Moreover neither the word "connotative" nor any

3/5

Szmada, 09/982,640, D/N 801001

Best Available Copy

In the first office action, Claims 1-10 and claims 39-42, 44 were rejected as being anticipated by Loeb et al. (U.S. 6,241,652) under 35 U.S.C. 102(e). Examiner asserted that the Loeb reference discloses a method for supplying advertisement information to a user..." In fact, the Loeb reference discloses "a method and system for providing free subscriptions to magazines based on a universal questionnaire." (Abstract to the application) This is not at all the same as the invention disclosed in the instant Application. In Examiner's latest correspondence, Examiner cites col. 9 lines 10-53 and asserts that this passage "clearly discloses that the system is an advertising system..." However, nowhere in the Loeb reference is recited or disclosed "receiving, from the user a series of search rules comprising facts about an advertisement." As discussed on page 22 of Applicant's response to first office action, the "universal questionnaire" cited by Examiner solicits "consumer professional information," also referred to as "certain consumer information," wherein are solicited the consumer name, consumer address, e-mail address, consumer profession, consumer title, field of specialty, qualification date and personal identifier. The foregoing in no way corresponds to "receiving, from the user, a series of search rules comprising facts about an advertisement," as recited in claim 1. As Examiner's response is understood, there is proffered no explicit teaching of "receiving, from the user, a series of search rules comprising facts about an advertisement," but rather that the service described by Loeb can be advertised, much as any other service can be advertised.

4/5

Szmanda, 09/982,640, D/N 801001

Best Available Copy

any manner in the Loeb reference including examiner's citations (Fig. 11C and col. 13, lines 23-28).

RECEIVED
CENTRAL FAX CENTER

FEB 09 2006

Examiner further rejects claims 11-38 as being unpatentable over the previously cited Loeb reference under 35U.S.C. §103(a). Based on the foregoing, the limitation "receiving, from the user, a series of search rules comprising facts about an advertisement," is nowhere taught or suggested in Loeb. Examiner did not address this or other arguments proffered by Applicant in Applicant's reply to first office action.

Based on the foregoing, Applicant respectfully requests reconsideration of Examiner's final office action.

Further, it is believed that claims 1,11,25,39 and 42 and the claims depending therefrom are in condition for immediate allowance, which action is earnestly solicited.

Dated this 9th day of February, 2006
Respectfully submitted,



Charles R. Szmanda
Agent for Applicant
Registration # 48,618
Telephone: 508 836 4143
FAX: 508 836 4143

5/5

Szmanda, 09/982,640, D/N 801001

Best Available Copy

BEST AVAILABLE COPY